

REMARKS

In accordance with the foregoing, claims 1 and 13 have been canceled, claims 21 and 22 have been withdrawn from consideration, claims 2, 3, 6-20 and 23-25 have been amended, and claim 26 has been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 2, 3, 6-20 and 23-26 are pending and under consideration. Reconsideration is respectfully requested.

Status of the Claims:

The Office Action mailed October 10, 2006 rejected:

claims 1-7, 12 15-17 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi (U.S. Patent 6,633,759), Kikinis (U.S. Patent 6,553,410) and Hendricks (U.S. Patent 5,986,690);

claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi, Kikinis, Hendricks and Helfman (U.S. Patent 6,119,135);

claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi, Kikinis, Hendricks and Kunkel (U.S. Patent 6,477,579);

claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi, Kikinis and Marmor (U.S. Patent 6,601,108);

claims 13, 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi, Kikinis, Hendricks, and Jungck (U.S. Patent 6,728,785); and

claim 14 under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, Kikinis, Hendricks and Betts (U.S. Patent 4,734,920).

Non-Prior Art Rejections:

In the Office Action, at page 2, claim 2 was rejected under the first paragraph of 35 U.S.C. §112. This rejection is traversed and reconsideration is requested.

As described in the last four lines of page 2, claim 25 was rejected under written description requirement of the first paragraph of 35 U.S.C. § 112, because the phrase "mutually exclusive with respect to other layers" is not mentioned in the specification. It is well established in U.S. law, however, that the exact phrasing of the claims is not required to appear in the written

description of the invention. For example, section 2163.02 of the Manual of Patent Examining Procedure (MPEP) states "[t]he subject matter of the claim need not be described literally (i.e. using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement" and cites numerous cases therein. Thus, the Office Action has not provided a proper basis for rejecting claim 25 under the written description requirement of the first paragraph of 35 U.S.C. § 112 because the Office Action merely stated the words in the claim did not appear in the written description.

The proper standard for determining whether a claim complies with the written description requirement of the first paragraph of 35 U.S.C. § 112 is summarized in section 2163.02 of the MPEP as whether "the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claims" (cites *In re Gosteli* 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)). With respect to claim 25, the Examiner identified the limitation "with each layer mutually exclusive with respect to other layers of the hierarchical data" (emphasis included) as not being defined in the specification. One embodiment of this limitation is described written description on page 14, line 4 to page 15, line 8 with reference to FIG. 9.

Thus, it is submitted that the rejection of claim 25 under the first paragraph of 35 U.S.C. § 112 was improper because the Office Action merely suggested the limitation was not defined in the specification instead of providing evidence that one skilled in the art would question whether the inventors invented what is claimed. Furthermore, there is support in the written description that would convey to one skilled in the art that the inventors had possession of the claimed limitation. In light of the foregoing, withdrawal of the rejection of claim 25 under the first paragraph of 35 U.S.C. § 112 is respectfully requested.

Prior Art Rejections:

New claim 26 recites

a portable viewer division, that can be carried by the user carrying said portable server division, displaying said book-type contents transmitted from said portable server division page-by-page so that a full page is displayed and including a compressed data decompressing function that decompresses an intermediate data file, in which a page constitutes a unit, the portable viewer division, after the intermediate data file has been transferred, expands a transferred compressed image by said compressed data decompressing function, and displays transferred compressed image every time the intermediate data is transferred

at lines 5-11. Nothing has been cited in the prior art of record that teaches or suggests is recited in claim 26. In particular, the Office Action cites Jungck as teaching a dynamic compression of

data in column 3, line 67 to column 4, line 5. Jungck, however, does not describe in any significant detail how the compression is accomplish and specifically does not describe "decompresses an intermediate data file, in which a page constitutes a unit" as recited in claim 26. What is described in the dynamic compression of Jungck, as shown in step 408 of FIG. 4 and 508 of FIG. 5, is a process that "selectively compress[es] the web page" and not "decompress[ing] an intermediate data file, in which a page constitutes a unit" or "display[ing] transferred compressed image every time the intermediate data is transferred" as recited in claim 1.

Claims 2, 3, 6, 7, 12, 15-17 and 19 depend, directly or indirectly, from claim 26 and include all the features of that claim plus additional features, which are not taught or suggested by the cited prior art. Therefore, it is submitted that claims 2, 3, 6, 7, 12, 15-17 and 19 are patentably distinguishable over the prior art, individually or in combination. Withdrawal of the rejections is respectfully requested.

On pages 3-13 of the Office Action, the Examiner rejected claims 9, 13, 14, 18 and 20 under 35 U.S.C. § 103 as unpatentable over various combinations of Kobayashi, Kikinis, Hendricks, Halfman, Kunkel, Marmor, Jungck and Betts.

Claims 9, 13, 14, 18 and 20 depend, directly or indirectly, from claim 26 and include all the features of that claim plus additional features, which are not taught or suggested by the prior art. Further, none of the additional references relied on by the Examiner teach or suggest the features of the present claimed invention as set forth in claim 1. Therefore, it is submitted that claims 9, 13, 14, 18 and 20 are patentably distinguishable over the cited prior art, individually or in combination. Withdrawal of the rejections is respectfully requested.

New claim 23 recites "transmitting a layered intermediate data file, converted from the page information of the book-type contents" at lines 5-6. It is submitted, for at least the reasons discussed above, that independent claim 23 and dependent claim 24, which depends therefrom and adds further patentable distinctions, are patentably distinguishable over the cited prior art, individually or in combination.

New claim 25 recites "receiving, from the portable server, layers of hierarchical data including layout information ... with each layer mutually exclusive with respect to other layers of the hierarchical data" at lines 4-7. It is submitted, for at least the reasons discussed above, that claim 25 is patentably distinguishable over the cited prior art, individually or in combination.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Serial No. 09/812,850

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: November 13, 2002

By: David E. Moore

David E. Moore
Registration No. 59,047

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501